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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 10/604,343 | 07/14/2003 | Wen-Yuan Chang | 112.P14030 | 1342 |
| 43831 | 7590 | 05/31/2006 | EXAMINER | |
| BERKELEY LAW & TECHNOLOGY GROUP | | | LE, THIEN MINH | |
| 1700NW 167TH PLACE | | | ART UNIT | |
| SUITE 240 | | | PAPER NUMBER | |
| BEAVERTON, OR 97006 | | | 2876 | |

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/604,343 | | CHANG ET AL. | |
| | Examiner | | Art Unit | |
| | Thien M. Le | | 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-17 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 4 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment filed on 9/21/2005 has been entered. Claims 1-17 and newly added claims 18-20 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5-6, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kahn et al. (herein after referred as Kahn – 5,864,130).

Regarding claims 1 and 18, Kahn discloses an optical reader (bar code reader) 30 which is mounted on a movable arm assembly 34 (which serves as the claimed carrier) for moving along a track 34 (which serves as the claimed guiding rail); a motor unit and its associating means (not shown) are used for moving the carrier 34 along the guide track 34 and are considered as the claimed driving unit and transmission unit; fasteners and brackets are used for holding the arm carrier in its position.

As can be seen, Kahn discloses the claimed invention.

Regarding claim 2, see figure 1-3 for the guide track 34 and the protruding portion of the carrier assembly.

Regarding claims 5-6, a typical laser scanner as taught by Kahn would inherently include a set of reflecting mirrors, a lens, and a charge couple device optical sensor; and thus would embrace all limitations set forth in this claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 3 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn et al. (Kahn – 5,864,130; cited above) in view of Lennemann et al. (herein after referred as Lennemann – 4,609,818).

Regarding claims 3 and 19, see the discussions regarding claims 1-2. The claim differs in calling for the claimed guiding rail section which is protruding from the wall of the housing.

However, this claimed limitation is not new. Reference to Lennemann is cited as evidence showing the conventionality of the claimed limitation. Specifically, Lennemann discloses an optical scanner wherein the scanner is supported by carriers and thus allowing the scanner to scan in more than one scanning directions. Figure 1 of Lennemann shows a optical scanning apparatus comprising carriers 4 and 12 for supporting optical reader 15; and especially, guide rails 2 and 3 which are protruding from the housing wall.

Without any unexpected result, it would have been obvious to incorporate the use of the guiding rails having the functional characteristics as recited by Lennemann in the system as taught by Kahn. The modification merely offers an alternative engaging method for the carrier and the rails which are well within the skill levels and expectations of an ordinary skilled artisan. Further, the incorporation of Lennemann's teachings of the rails can be used as supplements to the teachings as taught by Kahn to further secure the moving carrier to its place in operations.

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Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn et al. (Kahn – 5,864,130; cited above) in view of Nada et al. (herein after referred as Nada – 6,305,608).

Regarding claims 7-8, see the discussions regarding claim 1. The claim differs in calling for a housing which is made of soft and grind-resistant material such as polycarbonate resin, nylon, polyoxymethylene and polybutulene terephthalate.

However, this claimed limitation is not new. Reference to Nada is cited as evidence showing the use of the material groups such as polyacetal, nylon, polycarbonate, polystyrene or ABS for making the scanner's housing [col. 6, lines 55-68].

Thus, it would have been obvious to incorporate the teaching of using such aforementioned material in Kahn scanner's housing. An ordinary skilled artisan would have been motivated to use such materials since they have small coefficient of friction such that the carrier would slide smoothly on its surface.

Allowable Subject Matter

Claims 9-17 are allowed.

Claims 4 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose an optical reading system comprising the combination of an optical reader, a carrier, guiding rails, a driving unit, a transmission unit, etc. and further comprising the guiding rail having a U-shaped opening and characteristics as recited in claims 4 and 20.

The prior art fails to disclose an optical reading system comprising the combination of an optical reader, a carrier, guiding rails, a driving unit, a transmission unit, etc. and further comprising a guide rail having at least two base fastening sections, a sliding fastener, and having the characteristics as recited in claim 9.

Remarks

Applicant's arguments filed on 9/21/2005 have been fully considered but are not considered persuasive.

1. Applicant argues that claim 1 recites:

a. a carrier having a connecting unit having an optical mounted thereon.

** This limitation is clearly shown on figure of Kahn, wherein the optical scanner 30 is mounted on the carrier 34.

b. Applicant argues that Kahn does not show a casing having a guiding rail, wherein the guiding rail is formed on an interior wall of the casing an integral unit.

** The guiding rail 34 of Kahn, as shown in figure 1 is integrally formed on the interior wall casing, so that the whole carrier assembly can be mounted therein.

c. Applicant argues that Kahn does not show the guiding rail has at least a fastener to latch with the connecting unit for the carrier.

** In the descriptions of figures 1 and 2, Kahn discloses that "the angular position mount 40 includes a U-shaped bracket 46 holding the laser scanner 30. The bracket 46 permits the laser scanner 30 to have a range of rotational freedom about an X-axis, and the rotational position of which may be fixed by tightening the bracket about the laser scanner 30 with fasteners such as bolts and washers and the like. Rotation of the laser scanner 30 along the X-axis thus varies the angle of the laser scanner 30 with respect to the horizontal. The angular position of the laser scanner 30 may be noted by a graduated scale 48. The angular position mount 40 further provides the laser scanner 30 a range of rotational freedom about the Y- and Z-axes with a pendulum mounting member 50 and a vertical rotational mount 52, each equipped with a graduated scale 54 and 56 to provide angular position references about the respective axes. As shown, movement about the Z-axis may be accomplished by loosening fasteners or bolts 60 and 62, adjusting the angular position of the laser scanner 30 and tightening the bolts 60 and 62 after achieving the desired position."

The examiner is also took the views that the motor coupled with the carrier 34 is an inherent limitation. This is because a driving unit must be presence in Kahn's system to move the carrier 34 up and down the presentation axis as shown in figure 1.

As can be seen, Kahn discloses various fasteners for mounting the optical reader 30 on the carrier 34. (also see the entire descriptions of figures 1-2).

Applicant has not argued the patentability of other claims, thus, their grounds of rejection are respectfully maintained.

This Office Action has been made Final.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-

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2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Le, Thien Minh
Primary Examiner
Art Unit 2876
March 9, 2005